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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,999	04/24/2000	Roy Mickos	930.307US01	7677

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EXAMINER

PHAM, BRENDA H

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,999

Applicant(s)

MICKOS ET AL.

Examiner

Brenda Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 12 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 5-10, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION.

1. Claims 1-20 have been examined.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The disclosure is objected to because of the following informalities:

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (b) BRIEF SUMMARY OF THE INVENTION.
- (c) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (d) DETAILED DESCRIPTION OF THE INVENTION.
- (e) CLAIM OR CLAIMS (commencing on a separate sheet).
- (f) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 15, 19, and 20 are rejected under 35 USC 102(b) as being anticipated by **Lu et al** (US 5,999,813), hereinafter refer to as **Lu**.

-Regarding claims 1, 15, 19, and 20, **Lu** teaches a communications system and method comprising (referring to figure 6A, 6B) a first part (GSM network 450) and a second part (Public MSC 462), the first and second parts being connected so that a first user (458 or 460) in one of the first and second parts can communicate with a second user (470, 474 or 477) in the other of the first and second parts, wherein at least said first user (458 or 460) is able to move within the respective part of said system, said system further comprising a gateway (figure 6B) for permitting communications between said first and second parts (GSM network and Public MSC), said gateway comprising a register for storing information associating the said first and second user and for storing information (482) relating to the current location of the first user so that information from the second user can be directed to first user, (column 15, lines 40-63 and figure 3A).

-Regarding claim 2, **Lu** further teaches wherein when the location of the first user change, the information relating to the new location is stored in the register of the gateway (figure 3A).

-Regarding claim 3, **Lu** teaches wherein the first user is a mobile terminal (458, 460) which is in communication with a base station (456).

-Regarding claim 4, **Lu** furthermore teaches wherein said base station (456) is coupled to a respective network element and information relating to the said identity of said network element (mobile station 458 or 460) is stored in said register (HLR/VLR 482) as the current location information of the first user.

-Regarding claim 16, **Lu** also teaches wherein said second user is a fixed user (GMSC block 480 may also include a wired PBX interface 352 and internal network interface 456 for communicating respectively with a wired PBX and another cPBX, (column 17, lines 32-35)).

-Regarding claim 18, **Lu** teaches wherein said first user operates in accordance with the GSM standard, (GSM network 450).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lu et al** (US 5,999,813) in view of **Patel et al** (US 6,314,284 B1), hereinafter refer to **Patel**.

-Regarding claim 11 and 17, as explained above in the rejection statement of claim 1, **Lu** discloses all claim limitations recited in claim 1 (parent claim).

Although **Lu** does not teach wherein said system uses the Internet protocol and wherein second user operates in accordance with the H.323 protocol, these claimed

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features are well known and is taught by Patel, in according to figure 1 and column 2, lines 36-45).

The H.323 standard provides a foundation for audio, video and data communications across IP based networks, including the Internet. By complying to H.323, multimedia products and applications from multiple vendors can interoperate, allowing users to communicate without concern for compatibility. H.323 will be the keystone for LAN based products for consumer, business, entertainment and professional applications. Therefore, it would have been obvious to those having ordinary skill in the art at the time of the invention was made to use the Internet protocol and to implement the system of Lu in accordance with the H.323 protocol, such as that taught by Patel.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lu et al** (US 5,999,813) in view of **Hammond et al** (US 5,915,087), herein after refer to as Hammond.

-Regarding claim 12, as explained above in the rejection statement of claim 1, **Lu** discloses all claim limitations recited in claim 1 (parent claim).

Lu does not teach wherein said register stores source and destination ports and addresses.

Hammond, in the same field of endeavor teaches this limitation, in according to figure 3.

It would have been obvious to those having ordinary skill in the art at the time of the invention was made to implement a register stores source and destination ports and addresses to ensures that messages are properly routed via the correct ports.

Allowable Subject Matter

9. Claims 5-10, 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record fails to teach wherein an identifier allocated in the network element which is arranged to receive communications intended for said first user is stored in said register.

The prior art made of record does not teach wherein said register stores source and destination ports and addresses.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(US 6,539,237 B1), Sayer et al discloses a method and apparatus for integrated wireless communications in private and public network environment.

(US 5,943,399) Bannister et al discloses method and apparatus for providing communications to telecommunications terminals.

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(US 6,424,638 B1) Ray et al discloses system and method for performing an inter mobile system handover using the internet telephony system.

(US 6,044,269) Talagery discloses method for enhanced control of mobile call delivery.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Pham whose telephone number is (703) 308-0148. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Brenda Pham
August 10, 2003

